

REMARKS

Telephone call with the Examiner

Applicant thanks the Examiner for his courtesy and helpfulness in a telephone conversation with Applicant's undersigned representative on February 15, 2006. In that telephone conversation the Examiner indicated that the Advisory Action of November 11, 2005, responding to Applicant's Amendment and Response of January 24, 2005, was mailed after expiration of Appeal Period because the Amendment and Response of January 24, 2005, was never placed on his docket. Applicant's undersigned representative asked the Examiner what the deadline for responding to the Advisory Action of November 11, 2005, is and he replied that Applicant should respond as soon as possible.

Status of the Claims

Applicant understands from the Advisory Actions of September 27, 2004, and November 17, 2005, that the amendments submitted in the Responses of August 19, 2004, and January 24, 2005, have not been entered. Thus the amendments made herein are made to the claims as they appeared at the time of the Office Action of March 23, 2004, and include those made in the Responses referred to above. Thus, claims 1-54 are pending and claims 1-18 and 35-54 are under consideration in this application, claims 19-34 having been withdrawn as allegedly been drawn to a separate invention.

Claims 27-34 and 36-54 have been cancelled herein without prejudice to their being presented in one or more separate applications. In addition to amendments described below, various amendments to enhance clarity have been made.

Once the claims presently under consideration have been held allowable, Applicant proposes, pursuant to 37 C.F.R. § 1.121, to rejoin claims currently pending in the application and which are directed to methods of using the protein and compositions of claims 11-16. Relevant "method of use" claims include claims 19-26. Claims 19-26 have been amended to track the language of the claims presently under consideration.

After entry of the amendments made herein, claims 1-26 and 35 will be pending and claims 1-18 and 35 will be under consideration in this application.

None of the amendments made herein add new matter.

35 U.S.C. § 112, first paragraph, rejection

Claims 1-18 and 35 stand rejected on the grounds that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with the claims.

From the comments in Office Actions of July 1, 2003, and March 23, 2004, and the Advisory Actions of September 27, 2004, and November 17, 2005, Applicant understands the Examiner's position to be that, while the MTBN4 polypeptide is enabled by the instant specification with respect to specific antigenic properties, the other polypeptides (MTBN1-3 and 5-8) are not and that specification does not provide support for any of the polypeptides containing conservative substitutions while retaining *Mycobacterium tuberculosis* specific antigenic properties. In view of the arguments and articles presented in the Responses of December 23, 2003, August 19, 2004, and January 24, 2005, Applicant disagrees with the Examiner's position with regard to MTBN polypeptides other than MTBN4. Moreover, in view of the entirely routine nature of the experimentation one of skill in the art could perform in order to establish conservative mutations that could be tolerated in the relevant polypeptides without complete loss of their antigenic and immunogenic properties, Applicant also disagrees with the Examiner's position in regard to such conservative substitutions (Advisory Action of November 17, 2005, page 3, lines 1-4). However, in order to expedite prosecution of the instant application, Applicant has amended claims 1, 11, and 35 by deleting all peptides (or DNAs encoding them) except MTBN4, and removing text referring to polypeptides with conservative substitutions, from the claims. These amendments are made without prejudice to the embodiments specified by the deleted material being presented in one or more separate applications. Insofar as the Examiner believes the claims to be enabled at least with respect to the MTBN4 polypeptide, Applicant submits that these amendments place the above recited claims in condition for allowance.

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In light of the above considerations, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

35 U.S.C. § 112, second paragraph, rejection

Claims 36-54 stand rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

Applicant understands the Examiner's position to be that, because claims 36 - 54 are dependent on rejected claims, they are indefinite. Since claims 36-54 have been cancelled, Applicant respectfully submits that the rejection is moot.

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CONCLUSIONS

Applicant submits that the pending claims patentably define the invention and request that the Examiner permit the pending claims to pass to allowance.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicant's undersigned representative can be reached at the telephone number listed below.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 07763-043001.

Respectfully submitted,

Date: 3/3/06



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